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| 10/806,550 | 03/23/2004 | Andrew R. Daniels | 705560US3 | 2550 |
| 24938 | 7590 | 05/17/2005 | EXAMINER | |
| DAIMLERCHRYSLER INTELLECTUAL CAPITAL CORPORATION | | | STRIMBU, GREGORY J | |
| CIMS 483-02-19 | | | ART UNIT | |
| 800 CHRYSLER DR EAST | | | PAPER NUMBER | |
| AUBURN HILLS, MI 48326-2757 | | | 3634 | |

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/806,550

Applicant(s)

DANIELS ET AL.

Examiner

Gregory J. Strimbu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-10 and 12-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-10 and 12-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 5/13/05.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. It is suggested that the applicant amend the title to include the disengageable gear train.

The disclosure is objected to because of the following informalities: "pin 72 and the moves" on line 19 of page 6 is grammatically awkward and confusing.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 1, 2, 4-10 and 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as "to maintain" on lines 16-17 of claim 1 render the claims indefinite because it is unclear if the holding linkage actually holds the gear train in driving engagement or is merely capable of maintaining the driving engagement.

Recitations such as "a motor vehicle" on line 2 of claim 9 render the claims indefinite because it is unclear if the applicant is referring to the motor vehicle set forth above or is attempting to set forth another motor vehicle in addition to the one set forth above.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 4-10 and 12-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,711,855. Although the conflicting claims are not identical, they are not patentably distinct from each other because the holding linkage of U.S. Patent No. 6,711,855 maintains the engaged position of the gear train and thus meets the claim limitation of holding linkage maintaining the driving engagement including after the actuator is deenergized.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Dettling et al. Dettling et al. discloses a power drive mechanism 10 for power assisted opening and closing of a liftgate 24 pivotally mounted to a motor vehicle 12, said power drive

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mechanism comprising: a linking arm 42 pivotally connectable with the liftgate; a crank arm 40 pivotally mountable on the vehicle and pivotally connected with the linking arm; a pivotally mounted gear train 54, a drive motor 36 operatively connected with said crank arm through said gear train, said gear train being movable between an engaged position and a disengaged position, said engaged position effecting a driving engagement between the drive motor and the crank arm such that energizing said drive motor drivingly rotates said crank arm to responsively effect said opening and closing of said the liftgate and said disengaged position disengages said drive motor from said crank arm permitting movement of said crank arm without backdriving said drive motor; an actuator operatively connected with said gear train and being operable to effect said movement of said gear train, and a holding linkage 56 operatively connected between said gear train and said actuator to maintain said driving engagement once said actuator moves said gear train into the engaged position including after the actuator is deenergized, a controller 80, a gas strut assembly 32, a sector gear 70.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dettling et al. as applied to claim 1 above, and further in view of Mitchell. Mitchell

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discloses a gear train (not numbered, but seen in figure 2) comprising a plurality of gears 19, 21, 22 and being movable between an engaged position and a disengaged position, the engaged position effecting a driving engagement between a drive motor 14 and a driven element 2, such that energizing the drive motor drivingly rotates driven element and the disengaged position disengages the drive motor from the driven element permitting movement of the driven element without backdriving the drive motor, an actuator 17 operatively connected with the gear train and being operable to effect the movement of the gear train, a holding linkage 11, 23 operatively connected between the gear train and the actuator to maintain the driving engagement once the actuator moves the gear train into the engaged position, the holding linkage comprising a holding link 23 and a connecting link 11, a switch 31 electrically communicating with the actuator and operatively associated with the crank arm, a spring 13.

It would have been obvious to one of ordinary skill in the art to provide Dettling et al. with a pivotable gear train, as taught by Mitchell, to reduce the wearing of the gears while enabling the connection and disconnection of the drive motor with the lift gate.

Claims 9, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dettling et al. as applied to claim 1 above, and further in view of Moore et al.

Moore et al. discloses a vehicle having a power drive mechanism 38 for moving a lift gate 26 between opened and closed positions comprising a controller 120 to control operation of the power drive mechanism 38, a power operated latch mechanism 34 and a switch 124.

It would have been obvious to one of ordinary skill in the art to provide Dettling et al. with a control system and power operated latch mechanism, as taught by Moore et al., to increase the ease with which a user is able to open and close the liftgate.

Claims 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dettling et al. in view of Moore et al. as applied to claims 9, 12 and 14 above, and further in view of Mitchell. Mitchell discloses a gear train (not numbered, but seen in figure 2) comprising a plurality of gears 19, 21, 22 and being movable between an engaged position and a disengaged position, the engaged position effecting a driving engagement between a drive motor 14 and a driven element 2, such that energizing the drive motor drivingly rotates driven element and the disengaged position disengages the drive motor from the driven element permitting movement of the driven element without backdriving the drive motor, an actuator 17 operatively connected with the gear train and being operable to effect the movement of the gear train, a holding linkage 11, 23 operatively connected between the gear train and the actuator to maintain the driving engagement once the actuator moves the gear train into the engaged position, the holding linkage comprising a holding link 23 and a connecting link 11, a switch 31 electrically communicating with the actuator and operatively associated with the crank arm, a spring 13.

It would have been obvious to one of ordinary skill in the art to provide Dettling et al., as modified above, with a pivotable gear train, as taught by Mitchell, to reduce the

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wearing of the gears while enabling the connection and disconnection of the drive motor with the lift gate.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dettling et al. in view of Moore et al. as applied to claims 9, 12 and 14 above, and further in view of Stenemann. Stenemann discloses a power drive mechanism having an aluminum construction on lines 56-58 of column 11.

It would have been obvious to one of ordinary skill in the art to provide Dettling et al., as modified above, with an aluminum construction, as taught by Stenemann, to reduce the weight of the power drive mechanism.

Allowable Subject Matter

Claim 7, as best understood by the examiner, would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, absent applicant's own disclosure, fails to teach the entire combination of elements set forth in the claimed invention. Specifically, the prior art of record fails to teach a fixedly mounted pin and the holding link includes a slot having a holding notch, the holding notch slidably receiving the pin in the slot for guiding movement of the holding link such that the pin is in the holding notch when the holding

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linkage engages the gear train to the crank arm, the holding linkage biased to maintain the engaged position of the gear train. See claim 7, lines 2-6.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ingraham and Bronson et al. are cited for disclosing a pivotally mounted disengageable gear train.

Response to Arguments

Applicant's arguments filed March 31, 2005 have been fully considered but they are moot in view of the new grounds of rejection. However, it should be noted that the applicant has not claimed that the holding linkage holds the gear train in driving engagement once the actuator moves the gear train into the engaged position including after the actuator is deenergized. See lines 16-17 of claim 1 which merely recites that the actuator is capable of maintaining the engagement after the actuator is deenergized.

Conclusion

THIS ACTION IS NOT MADE FINAL.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 571-272-6836. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Gregory J. Strimbu", with a long horizontal flourish extending to the right.

Gregory J. Strimbu
Primary Examiner
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May 13, 2005